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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,316	02/15/2002	Geoffery Wilson	1512.2.105	9859

21552 7590 10/06/2003

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT PAPER NUMBER

3711

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,316

Applicant(s)

WILSON, GEOFFERY

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 15-34 is/are pending in the application.
- 4a) Of the above claim(s) 3,15,16 and 20-34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-2, 4-11, and 17-19 is/are allowed.
- 6) ☒ Claim(s) 3,15,16 and 20-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3, 15-16 and 20-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Combining claims 1 and 3 or 20 does not make sense since it is not enabling to one skilled in the art. It is uncertain how to have an outer shaft having an internal tube fastened which can engage an inner shaft part and an inner shaft being splayed or having split ends. None of the drawings show this feature. Is the conical bore positioned in the inner shaft? When the inner shaft is moved telescopically to adjust the length of the shaft than the conical bore would be moved from the expander. The bolt (24), stop and spring (7) does not seem to be designed to allow significant changes between the outer shaft and the inner shaft to be able to move the expander to where the conical bore is located if it is part of the inner shaft and the inner shaft is relocated a significant amount. Combining claims 1 and 15 does not make sense since it is not enabling to one skilled in the art. Where would the internal tube be located?

Election/Restrictions

3. Claims 3, 15-16 and 20-34 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Claim 20 requires the inner shaft to be splayed which reads on figures 6-7 which is not the elected species of figure 2 (Species 1). The changes to claim 1 would not also read on figures 6-7 since claim 1 requires an outer shaft having an internal tube fastened which can engage an inner shaft part and claim 1 also requires the locking mechanism comprising an inner tube part having a split end provided by one of the inner shaft part and the internal tube. Figures 6-7 do not contain an outer shaft having an internal tube fastened which can engage an inner shaft part. Therefore combining claims 1 and 20 does not make sense in that it produces an apparatus which has not been disclosed (an outer shaft having an internal tube fastened which can engage an inner shaft part and an inner shaft being splayed). Claim 15 requires a moveable member of a locking mechanism comprising a shaft mounted for rotation within a bore in a head of the expander control member which seems to be directed to figures 6-7 which again does not contain the requirements of claim 1 of an outer shaft having an internal tube fastened which can engage an inner shaft part and claim 1 also requires the locking mechanism comprising an inner tube part having a split end provided by one of the inner shaft part and the internal tube. Again combining claims 1 and 15 does not make sense in that it produces an apparatus which has not

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been disclosed (an outer shaft having an internal tube fastened which can engage an inner shaft part and a moveable member of a locking mechanism comprising a shaft mounted for rotation within a bore in a head of the expander control member). Claim 3 requires an inner shaft part having a split end which is received within an internal tube. the inner shaft to be splayed which reads on figures 6-7 which is not the elected species of figure 2 (Species 1). The changes to claim 1 would not also read on figures 6-7 since claim 1 requires an outer shaft having an internal tube fastened which can engage an inner shaft part and claim 1 also requires the locking mechanism comprising an inner tube part having a split end provided by one of the inner shaft part and the internal tube. Figures 6-7 do not contain an outer shaft having an internal tube fastened which can engage an inner shaft part. Therefore combining claims 1 and 20 does not make sense in that it produces an apparatus which has not been disclosed (an outer shaft having an internal tube fastened which can engage an inner shaft part and an inner shaft being splayed).

Specification

4. The adding headings to the specification is agreed with.

Claim Rejections - 35 USC § 112

5. Changes to the claims are agreed with and the rejections under 35 U.S.C. 112, second paragraph, are removed.

Allowable Subject Matter

6. Claims 1-2, 4-11, and 17-19 are allowed. None of the prior art discloses or renders as obvious an outer shaft flaring outwardly from its open end in addition to the other elements of structure claimed. Modifying Andis would destroy the reference due to the design having projections and recesses which works with cylindrical shafts but not for tapered shafts.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Paul Sewell whose telephone number is (703) 308-2126. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9302, TC 3700 After Final Fax 703-872-9393, RightFax 703-746-3203)

Slb/ 1 October 2003


STEPHEN BLAU
PRIMARY EXAMINER